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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,040	08/16/2005	Cornelia Weiss	10191/3588	2766
26646	7590	08/22/2007	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				NGUYEN, CUONG H
ART UNIT		PAPER NUMBER		
		3661		
MAIL DATE		DELIVERY MODE		
		08/22/2007 PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/517,040	WEISS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	CUONG H. NGUYEN	3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on the IDS filed on 12/06/2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10,11,13,14,17 and 18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 10-18 are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. This Office Action is the answer to an IDS received on 12/06/2004.
2. Claims 1-18 are pending in this application; wherein claims 1-9 were canceled..

### ***Priority***

3. This application claims a Germany priority of 6/10/2002.

### ***Drawings***

4. 4 sheets of informal drawing were filed on 12/06/2004.

The limitation of claim 10: “communicating via an air interface, between the data terminal and a service center” need to be indicated in a drawing.

### ***Claim Rejections - 35 USC § 112***

5. Claims 10-11, 13-14, and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is vague when claiming “an air interface” (what is an air interface?); a replacement for this claimed language is requested to reflect a closer meanings.

6. A structural relationship in claim 10 is missing, the examiner fails to see an existing of a meaningful relationship between 3 phrases in the body of claim 10:

- communicating via an air interface, between the data terminal and a service center; and
- communicating between the data terminal and at least one control unit in the vehicle using at least one additional interface;

- wherein a same application protocol is used for the telematics service both for the communication via the air interface and the communication in the vehicle.

The last portion of claim 10's body is unclear (also in claim 17); what is "a same application protocol is used ..." does this claim 10 answers a USPTO requirement for "useful, concrete, and tangible results" knowing that it is a method claim.

***Election/Restrictions***

7. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 10-16 are drawn to a method for a vehicle-related telematics service,

classified in class 701, subclass 24

II. Claims 17-18 are drawn to a device/apparatus for a vehicle-related telematics service, classified in class 701, subclass 002.

The inventions are distinct, each from the other because of the following reasons:

Group I is directed to a method, comprising steps for establishing communications; and

Group II is directed to a concrete device, comprising physical components; therefore, this application comprises both an apparatus and a method of use that apparatus.

Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product/device as claimed can be used in a materially different process of using that product (e.g., the claimed device for

telematic services can be used for communications between a notebook computer (or vehicle's processors) and other host servers).

8. Applicant is required under 35 U.S.C. 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the group that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

9. Remark: The examiner submits that the applicant's very broad pending claims are merely directed to wireless communication between a mobile device and a stationery device.

10. About manner of claiming:

According to MPEP,

- I. The definition of the matter for which protection is sought shall be in terms of the technical features of the inventions.
- II. Whenever appropriate, claims shall contain:

- A statement indicating those technical features of the invention which are necessary for the definition of the claimed subject matter but which, in combination, are part of the prior art,

- A characterizing portion – preceded by the words “characterized in that,” “characterized by,” “wherein the improvement comprises,” or any other words to the same effect – stating concisely the technical features which, in combination with the features stated under (I), it is desired to protect.

The claims must “define the matter for which protection is sought.” Claims must be clear and concise. They must be fully supported by the description. The physical requirements for the claims are the same as those for the description.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (email address: cuong.nguyen@uspto.gov). The examiner can normally be reached on 9:30 am - 5:30 pm. Mon. – Tues., and Thurs. – Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

*Cuong H. Nguyen*  
CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3661